

R E M A R K S

- Claims **10-61** are currently pending;
- Claims **10-41** have been withdrawn;
- Claims **42-61** are rejected.
- Claims **44-46 and 49-50** have been canceled.
- Of the pending claims, claims **42 and 43**, are independent;
- This submission is being filed concurrently with a Request for Continued Examination (RCE) in compliance with 37 C.F.R. 1.114, to ensure consideration thereof.

1. Election/Restrictions

The Examiner asserted that “This application contains claims 10-41 drawn to an invention nonelected without traverse (implicit) in the reply filed on May 30, 2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.”

Applicants respectfully respond by noting that MPEP § 821.01, to which the Office refers, is directed to elections *with*. In contrast, the appropriate section directed to elections without traverse is MPEP § 821.02, again, as evidenced by the section title “After Election Without Traverse”. As a result, , Applicants respectfully prefer to proceed via the course outlined in that section (whereby the withdrawn claims are cancelled via a Examiner’s Amendment if and when some claims are found to be allowable).

2. Section 102 Rejections

Claims **42-55, 57-58 and 60-61** stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,012,983 to Walker et al. (“Walker” herein). Applicants respectfully traverse the rejection of these claims based on the reasons presented below.

2.1 Independent Claims 42 and 43

Applicants respectfully submit that each of amended independent claims **42 and 43** recite the following limitations that are not taught or suggested by Walker:

- *determin[ing], based on the gaming activities, a prompt comprising an offer for at least one of a product or service to be presented by an individual to the player; and*
- *transmit[ting] the prompt to the individual*

Applicants note that limitations similar to the limitation cited above were in now-cancelled dependent claims **44 – 46**, which were rejected by the Office. Accordingly, Applicants would like to take the opportunity to distinguish these limitations from Walker in the context of responding to the Office’s assertions with respect to dependent claims **44 – 46**. Specifically, in support of the rejection of claims **44 – 46**, the Office cites to the concept of prompting in Walker at col. 4, line 64 – col. 5, line 6. This passage of Walker states:

The player tracking device 300 also includes a display 320, having a touch screen, or a keypad 330. In operation, as discussed below, the slot machine 2 may display a message prompting the player to enter player parameter selections. In the present embodiment, a player enters the player

parameter selections via the display 320 which includes a touch screen. In an alternative embodiment, the player enters the player parameter selections via a keypad 330, which is part of the tracking device 300 and, therefore, in communication with the CPU 210.

Applicants respectfully submit that neither this passage, nor the remainder of Walker teaches or suggests the claimed limitation of *transmit[ting] the prompt to the individual* as recited in claims **42 and 43**, bearing in mind that *the individual* is an entity other than the player (evidenced by the fact that the player is a distinct entity recited in the claims). Rather, Walker discloses displaying a message to *the player*.

At least for this reason, Applicants respectfully submit that claims **42 and 43** are in condition for allowance. As all of claims **47-48 and 51-61** depend upon claims **42 and 43** and include all of the elements of claims **42 and 43**, claims **47-48 and 51-61** are likewise in condition for allowance. Applicants note that the rejections of claims **44-46 and 49-50** are rendered moot by the cancellation of claims **44-46 and 49-50**.

3. Section 103 Rejections

Claims **42** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Finnegan. (“Finnegan” herein). Applicants respectfully traverse the rejection of this claim based on the reasons presented below.

Specifically, Applicants assert that Finnegan fails to teach or otherwise suggest the following elements of claim **42** as currently amended:

- *determin[ing], based on the gaming activities, a prompt comprising an offer for at least one of a product or service to be presented by an individual to the player; and*
- *transmit[ting] the prompt to the individual*

It is well settled that "The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements were known in the prior art** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395

Applicants simply assert that Finnegan nowhere teaches or otherwise suggests *determin[ing], based on the gaming activities, a prompt comprising an offer for at least one of a product or service to be presented by an individual to the player or transmit[ting] the prompt to the individual or transmit[ting] the prompt to the individual* as recited in claim 42.

For these reasons, Applicants assert that claim 42 is in condition for allowance.

Applicants note that the Office further rejected claims **56** and **59** under 35 U.S.C. 103(a) as being unpatentable over Walker. Applicants refer to section 2.1 of this Action wherein it is asserted that claims **56** and **59** are in condition for allowance.

4. Response to Arguments

Applicants wish to respond to various assertions of the Office put forth in the Response to Arguments section of the Office Action.

First, the Office states:

As stated above reiterated here, Applicants' remark fails to consider that the cellular telephone implicitly includes cellular telephone circuitry and where Walker does not stipulate any limitation that negates use of its cellular circuitry of cellular telephone as remote communication device inclusive of communicating with any individual via cellular circuitry. Walkers' cellular telephone has distinct structure implicit and Walkers disclosure did not present any exception to this. Thus, the Office inquires whether Applicant is stating on the record that Walkers cellular telephone ceases or is prohibited to function when 'at the gaming device'; and, if Applicant is making that affirmative statement on the record, to require such as under 105 the Applicant provide factual support thereto whether from citation from the reference or as a declaration or affidavit for Office consideration since at present, the Office maintains, the cellular telephone as a portable communication device in Walker (3:57) continues to function 'at the gaming device' at least since there is no disclosed prohibition/exclusion for its circuitry to not function. (Response to Arguments section, page 5).

Applicants wish to both specifically and respectfully state that Applicants are most emphatically not making, nor have they made previously, an affirmative statement on the record regarding whether or not "Walkers cellular telephone ceases or is prohibited to function when 'at the gaming device'". In fact, as Applicants made clear in the Response of July 3, 2008, Walker teaches that a player can remotely enjoy ongoing play of the gaming device. If the player wishes to alter a limiting criteria, the player may do so "by returning to the machine and making appropriate adjustments". Conversely, the player may alter the limiting criteria remotely through a telephone call or other communication to casino personnel. It is therefore clear that the player can return to the gaming device to make alterations absent any communication to another individual, or, conversely, can remotely communicate with an individual, such as casino personnel.

Furthermore, it is abundantly evident that such remote communications refer to communications made by a player that is remote from the gaming device.

As is evident, no part of this these straightforward observations involves a statement, let alone an affirmative statement, regarding the functional status of a cellular telephone. What is most emphatically stated is that the player taught by Walker is remote from the gaming device. In contrast, the recited player of both of claims **42 and 43** is “at a gaming device”.

Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham via the contact information provided below.

Authorization to Charge Fees

Applicants believe a three-month extension of time to make this Amendment and Response timely is necessary. Accordingly, Applicants hereby petition for a three-month extension of time necessary to make this submission timely. Additionally, please charge any fees that may be required for this submission including the fee for the three month extension of time as follows:

Deposit Account: 50-0271

Order No. 02-058

Charge any additional fees or credit any overpayment to the same account.

Respectfully submitted,

March 12, 2009

Date

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